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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,625	12/11/2003	Valerie M. Bennett	RSW920030295US1	2663
43168 7590 01/11/2008 MARCIA L. DOUBET LAW FIRM PO BOX 422859 KISSIMMEE, FL 34742			EXAMINER ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	
			NOTIFICATION DATE	DELIVERY MODE
			01/11/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mld@mindspring.com



<b>Office Action Summary</b>	Application No. 10/733,625	Applicant(s) BENNETT ET AL.	
	Examiner David E. England	Art Unit 2143	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).


\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

*DE*



 Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date  
:12/11/03,01/22/07,04/10/07,09/23/07.



### **DETAILED ACTION**

1. Claims 1 – 12 are presented for examination.

#### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claim language of “computer-readable media” is not defined or found in the specification. What is stated in the specification is computer readable memory or computer-usable storage media, which appears to be the actual language that the Applicant means to use, [0078] – [0082]. It is asked that the Applicant amend the claim language of claims 10 - 12 to a memory of some type as stated in the last 5 paragraphs of their specification, [0078] – [0082].

#### ***Claim Objections***

3. Claims 9 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 9 and 12 disclose the similar teachings that are already stated in their independent claims 7 and 10. Furthermore, the means are adapted for which can be interpreted as not specifically able to do but optional to perform, intended use.

#### ***Claim Rejections - 35 USC § 101***



4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 7 – 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. The claim limitations teach a system, which is known in the art to not always be hardware. Proof of this is stated in the Applicant's specification in paragraph [0078], which states, "Accordingly, the present invention may take the form of an entirely hardware embodiment, an entirely software embodiment, an embodiment combining software and hardware aspects." It is seen here that the Applicant intends for the limitation to also be interpreted as only software.

7. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer- readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.



8. Furthermore, since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process.

9. Claims 8 and 9 are also rejected under 35 U.S.C. 101 because they do not further limit the language to teach hardware.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 10 – 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claims 10 – 12 utilize claim language that attempts to invoke 112 sixth paragraph, “means plus function”. The claims are rejected under 112 second paragraph for not describing any structure to perform such acts, i.e., the claims only describe code which has no physical structure and the specification does not appear to teach a means that would suggest a physical structure performing these acts. Further support for this assumption is seen in the objection to the specification in regards to a lack of definition to “computer readable medium”. See MPEP 2181.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linker et al. (7113921), hereinafter Linker, in view of Aarnio (7010500).

15. Referencing claim 1, as closely interpreted by the Examiner, Linker teaches a method of enabling users to subscribe to content in a computing environment, comprising steps of:

16. identifying behavior patterns of a user, (e.g., col. 10, line 60 – col. 11, line 3 & col. 12, lines 32 – 60, behavior, historical data);

17. using the identified behavior patterns to identify content which may be of interest to the user, (e.g., col. 10, line 60 – col. 11, line 3, *"The invention employs a client profile to customize the presentation of a graphical user interface such as a point of entry page with particular features and products related to the repeat client's preferences."* & col. 12, lines 32 – 60); and

18. offering, to the user, a subscription to the identified content, (e.g., col. 8, lines 35 – 54 & col. 12, lines 32 – 60). Linker teachings appear to be vague in the description of whether or not the user must select the identified content to be offered a subscription or it is "pushed" to the user utilizing the history data, without the user selecting the content to be offered a subscription.

19. Aarnio teaches offering, to the user, a subscription to the identified content, without requiring the user to initiate a request for the subscription, (e.g., col. 4, lines 34 – 46). It would have been obvious to one of ordinary skill in the art to combine Aarnio's offering a subscription to identified content without the user having to initiate a request for the subscription, with Linker's ability to determine specific behavior patterns to identify content because it would be



more efficient for vendors that are attempting to sell specific content to advertise to users that would be interested in their specific content utilizing the behavior history of a user browsing, rather than sending to unknown users that may not be interested, in any way, in their product, i.e., selective advertisement. Sending content that a user would more likely be interested in would give a vendor a better chance in selling said content.

20. Referencing claim 2, as closely interpreted by the Examiner, Linker teaches registering the offered subscription, upon acceptance thereof by the user, (e.g., col. 8, lines 35 - 54); but does not seem to specifically teach using the registered subscription to deliver the identified content to the user.

21. Aarnio teaches using the registered subscription to deliver the identified content to the user, (e.g., col. 5, lines 19 - 48). It would have been obvious to one of ordinary skill in the art to combine Aarnio with Linker because Aarnio's download of content allows the user to have the content they have subscribed for immediately as opposed to waiting a length of time before the user can use the content, i.e., mailing the content.

22. Referencing claim 3, as closely interpreted by the Examiner, Linker teaches customizing, for the user, the offered subscription such that at least one condition is placed on at least one portion of the identified content, wherein the at least one portion may comprise the identified content in its entirety, (e.g., col. 7, lines 45 - 58, steps 1 - 4); and

23. registering the offered subscription, as customized by the user, upon acceptance thereof by the user, (e.g., col. 7, lines 45 - 58, steps 1 - 4, & Figure 5 with enabling areas of the



specification).

24. Referencing claim 4, as closely interpreted by the Examiner, Linker does not specifically teach using the registered subscription to deliver the identified content which matches the conditions to the user.

25. Aarnio teaches using the registered subscription to deliver the identified content which matches the conditions to the user, (e.g., col. 3, lines 33 - 50, *"user-specific information includes the capabilities of the user's hardware... and the user's preferences..."* this could be considered conditions, col. 4, lines 34 et seq. for delivering said content). It would have been obvious to one of ordinary skill in the art to combine Aarnio with Linker because sending content that adheres to the users conditions would guarantee that the user receives content that caters to the user's system or needs, i.e., if the device that the user is using to receive the information does not have the hardware to handle the content then it is of no use to the user at that time.

26. Referencing claim 5, as closely interpreted by the Examiner, Linker does not specifically state specifying, for the user, at least one action to be carried out when the conditions are matched in the identified content.

27. Aarnio teaches specifying, for the user, at least one action to be carried out when the conditions are matched in the identified content, (e.g., col. 3, lines 33 – 50, *"...enables the server download data in a format compatible with the mobile terminal's protocol and the user network's protocol."*). It would have been obvious to one of ordinary skill in the art to combine Aarnio with Linker because formatting the information to the user's specific conditions enables



the server download data in a format compatible with the mobile terminal's protocol and the user network's protocol.

28. Referencing claim 6, as closely interpreted by the Examiner, Linker teaches evaluating the registered subscription, (e.g., col. 10, line 45 - col. 11, line 3, repeat client can be determined), but does not specifically teach if the condition(s) therein are met in the identified content, carrying out the action(s).

29. Aarnio teaches if the condition(s) therein are met in the identified content, carrying out the action(s), (e.g., col. 3, lines 33 – 50). It would have been obvious to one of ordinary skill in the art to combine Aarnio with Linker because of similar reasons stated in the rejection of claims 4 and 5.

30. The teachings and motivation to combine teachings for claims 7 and 10 can be found in similar light as claim 1.

31. The teachings and motivation to combine teachings for claims 8 and 11 can be found in similar light as claim 2.

32. The teachings and motivation to combine teachings for claims 9 and 12 can be found in similar light as claim 1.

### ***Conclusion***

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



- 34. a. Bennett et al. U.S. Pub. No. 2005/0131889 discloses Information aggregation and synthesization system.
- 35. b. Bennett et al. U.S. Pub. No. 2005/0131778 discloses Associative search engine.
- 36. c. Grandy et al. U.S. Pub. No. 2004/0205811 discloses Method of delivery, targeting, and measuring advertising over networks.
- 37. d. Hartsman et al. U.S. Pub. No. 2004/0181448 discloses Adaptive communication data retrieval system.
- 38. e. Tijerino U.S. Patent No. 6405034 discloses Marketing network.
- 39. f. Merriman et al. U.S. Patent No. 5948061 discloses System and method for providing integrated media.
- 40. g. Skillen et al. U.S. Patent No. 6098065 discloses Customized subscription builder.
- 41. h. Bull et al. U.S. Patent No. 6208975 discloses Intelligent data query builder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



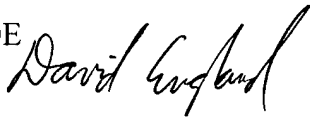
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David E. England  
Examiner  
Art Unit 2143

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A handwritten signature in black ink, appearing to read "David England", written over a horizontal line.